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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/681,183  | 02/13/2001  | Stephan P. Capps     | MCS-058-00          | 7809             |
| 27662   | 7590        | 01/27/2006           | EXAMINER            |                  |
| MICROSOFT CORPORATION<br>C/O LYON & HARR, LLP<br>300 ESPLANADE DRIVE<br>SUITE 800<br>OXNARD, CA 93036 |             |                      | CORRIELUS, JEAN M   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2162                |                  |
| DATE MAILED: 01/27/2006   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/681,183 | <b>Applicant(s)</b><br>CAPPS, STEPHAN P. |  |
|                              | <b>Examiner</b><br>Jean M. Corrielus | <b>Art Unit</b><br>2162                  |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on October 31, 2005, in which claims 1-2 and 4-50 are presented for further examination.

### ***Response to Arguments***

2. Applicant's arguments filed on October 31, 2005 have been fully considered but they are not persuasive. (See Examiner's remark).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee US Pub. No. 2002/0087521 and Thorner et al., (hereinafter “Thorner”) US Patent no. 6,463,443.

As to claim 1, “automatically parsing an electronic document, said electronic documents including any of a word processor document, an Internet Web Page, a spreadsheet, and any textual and graphical data rendered on a display device to identify data representing any person” by automatically dividing the electronic file into separately searchable word sets, wherein the division made according to sentence and paragraph breaks in the file (page 1, [0006], [0015], [0019]); “identifying at least one person represented by the identified data” identifying word or words sequences which represented candidate names (page 1, [0007], [0012],[0020]). Lee does not explicitly disclose the claimed “automatically retrieving information relating to each identified person from at least one electronic database; notifying the user that the retrieved information is available; and using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide at least one electronic interface for initiating communication with those identified persons.

On the other hand, Thorner teaches the claimed automatically retrieving information relating to each identified person from at least one electronic database” (col.4, lines 59-67; col.6, lines 27-39); “notifying the user that the retrieved information is available” (Thorner, col.4, lines 40-61, CCA person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject -information . . .)” and “using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide at least one electronic interface for initiating communication

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with those identified persons (Thorner col. 4, lines 62-67, (Automatic connection to a inquired person/family/company", col. 7, lines 43-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the system for searching electronic files as disclosed by Lee would incorporate the use of automatically retrieving available information and providing at least one electronic interface for initiating communication with those identified person. One having ordinary skill in the art would have found it motivated to combine the teachings of the cited references in order to provide desired information about person's communication possibilities and residence in easy way without installation adapted to particular kind of communications system.

As per claim 4, Lee and Thorner teach substantially the invention as claimed. In addition, Thorner discloses the claimed "wherein the at least one electronic interface for initiating communication with one or more of the identified persons includes any of an email address, an instant message, a telephone number, a fax number, and an Internet address for communicating with the identified person (Thorner, col. 7, lines 42-55).

As per claim 5, Lee and Thorner teach substantially the invention as claimed. In addition, Lee teaches the claimed "wherein parsing an electronic document to identify data representing any person comprises identifying textual data associated with any person (Lee, page 1, (00051-(0020), page 2, (0032)-g0033)).

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As per claims 6 and 35, Lee and Thorner teach substantially the invention as claimed. In addition, Lee teaches the claimed “wherein the textual data associated with any person includes any of: a name, an email address, a telephone number, a fax number, and a social security number (Lee, page 1, (00051)-(00201, page 2, (0032)-gO033)).

As per claims 9 and 36, Lee and Thorner teach substantially the invention as claimed. In addition, Thorner teaches the claimed “wherein identifying at least one person represented by the identified data comprises comparing the identified data to information in at least one electronic database to identify each person associated with the identified data (Thorner, col. 4, lines 40-67).

As per claim 11, Lee and Thorner teach substantially the invention as claimed. In addition, Thorner teaches the claimed “wherein notifying the user that the retrieved information is available comprises automatically providing a visible alert when the information is retrieved from the at least one electronic database (Thorner, col. 8, lines 15-20).

As per claim 20, Lee and Thorner teach substantially the invention as claimed. In addition, Thorner teaches a graphical user interface for interacting with the retrieved information” (Thorner, col. 4, lines 62-67).

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As per claim 24, Lee teaches a computer-implemented process for automatically providing information on a computer display device, comprising: “automatically scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person (Lee, page 1, (00052- (0020), 'page 2, (0032)- (0033)); identifying each person represented by the identified information (Lee, page 1, (00052- (0020), page 2, (0032)-(0033)). Lee does not explicitly disclose automatically retrieving information relating to each identified person from at least one electronic database; providing an alert for indicating that the retrieved information is available; using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide a user interface for initiating communication with those identified persons via at least one electronic communication access point. On the other hand, Thorner teaches the claimed automatically retrieving information relating to each identified person from at least one electronic database” (col.4, lines 59-67; col.6, lines 27-39); “notifying the user that the retrieved information is available” (Thorner, col.4, lines 40-61, CCA person A at the computer 1 states that he/she intends to make a database search for a person and/or family, and/or organization related information, below called subject -information . . .') and “using at least a portion of the retrieved information relating to one or more of the identified persons to automatically provide at least one electronic interface for initiating communication with those identified persons (Thorner col. 4, lines 62-67, (Automatic connection to a inquired person/family/company", col. 7, lines 43-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the system for searching electronic files as disclosed by Lee would incorporate the use of automatically retrieving

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available information and providing at least one electronic interface for initiating communication with those identified person. One having ordinary skill in the art would have found it motivated to combine the teachings of the cited references in order to provide desired information about person's communication possibilities and residence in easy way without installation adapted to particular kind of communications system.

6. Claim 2 is rejected under 35 U.S.C. 1 03(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) and Thorner et al., (hereinafter "Thorner" US 6,463,443) as applied to claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 and further in view of Srinivasan (US 6,717,936).

As per claim 2, Lee and Thorner substantially teach the invention as claimed. However, neither Lee nor Thorner explicitly discloses the at least one electronic interface for initiating communication is displayed to a user as an icon representing at least one communication access point related to the retrieved information. Srinivasan teaches the claimed "at least one electronic interface for initiating communication is displayed to a user as an icon representing at least one communication access point related to the retrieved information" (Srinivasan, col. 6, lines 62-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lee and Thorner's combined system by incorporating the icon as disclosed by Srinivasan (Srinivasan's col. 6 lines 62-64). One having ordinary skill in the art at the time the invention was made to use such a modification for the purpose of efficiently selecting mode for establishing communication between user and subscriber



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7. Claims 7, 8 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub.

No.: US 2002/0087521 A1) and Thorner et al. (Thorner" US 6,463,443) as applied to claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 and further in view of Dimitrova (US 6,363,380).

As per claim 7, Lee and Thorner substantially teach the invention as claimed, except for explicitly disclosing parsing an electronic document to identify data representing any person comprises identifying graphical data associated with any person.

Dimitrova, on the other hand, teaches parsing graphical data to identify person (Dimitrova, col. 12, lines 1-7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating a graphical parser as disclosed by Dimitrova (Dimitrova, col. 12, lines 1-7). The motivation being to enable the system to identify not only textual data but also graphical data associated with a person.

As per claim 8, Lee, Thorner and Dimitrova teach all the claimed subject matters as discussed in claim 7, and further teach the graphical data associated with any person includes any image for representing at least one person (Dimitrova, col. 12, lines 1-7).

As per claim 39, Lee, Thorner and Yamakita teach all the claimed subject matters as discussed in claim 38. In addition, Dimitrova teaches identifying characteristics of at least one image within the electronic document using at least one image recognition technique (Dimitrova, col. 12, lines 1-7).

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8. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub No: US 2002/0087521 A1) and Thorner et al. (Thorner" US 6 463 443) as applied to claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 and further in view of Sorensen (US 6,628,729).

As per claims 10 and 12, Lee and Thorner substantially teach the invention as claimed, except for explicitly disclosing wherein notifying the user that the retrieved information is available comprises automatically providing an audible alert when the information is retrieved from the at least one electronic database. Sorensen teaches providing an audible alert when information is retrieved (Sorensen, col. 3, lines 27-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating an audio alert as disclosed by Sorensen (Sorensen, col.3, lines 27-30). The motivation being to promptly remind the user that information is available.

9. Claims 13-15, 26-30, 37, 38, 40-45 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub No: US 2002/0087521 A1) and Thorner et al. (Thorner" US 6 463 443) as applied to claims 1, 4-6, 9, 11, 20, 24, 25, 35 and 36 and further in view of Yamakita (US 6,272,490).

As per claims 13, 15, 26-30, 37, 38, 40-45 and 50, Lee and Thorner substantially teach the invention as claimed, except for explicitly disclosing the visible alert comprises dynamically modifying the appearance of the electronic document. Yamakita teaches the visible alert comprises dynamically modifying the appearance of the electronic document (Yamakita, abstract, (word is highlighted")). Therefore, it would have been obvious to one of ordinary skill in

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the art at the time the invention was made to modify the Lee and Thorner's combined system by modifying the appearance of the electronic document as disclosed by Yamakita. The motivation being to notify the user the information is available.

As per claim 14, Lee, Lee and Thorner substantially teach the invention as claimed. In addition, Yamakita teaches the claimed "changing the appearance of the identified data" (abstract, "word is highlighted").

10. Claims 16-19, 21-23 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (Pub. No.: US 2002/0087521 A1) in view of Thorner et al. ("Thorner" US 6,463,443) and further in view of Appelman et al. ("Appelman" US 6,539,421).

As per claims 16 and 31, Lee and Thorner substantially discloses the invention as claimed, except for explicitly disclosing the visible alert comprises dynamically adding at least one presence indicator to the electronic document. However, Lee and Thorner teach using electronic communication (email) to communicate with a person. On the other hand, Appelman teaches using instant messaging, which is a type of electronic communication system, to communicate with a person (Appelman, col. 4, lines 24-30). Instant messaging system provides a visible alert that adds presence indicator associated with the person (Appelman, col. 5, lines 52-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by using a instant messaging system with presence indicator as disclosed by Appelman to communicate with the identified person. The motivation being to provide a faster and efficient way to communicate with the

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identified person because with email system, the message sender will never know when the person will read the email and reply to the email message. Instant message system tells the user whether the person is online or not, and allows the user to communicate with the person right away in real time.

As per claims 17 and 32-34, Lee, Thorner and Appelman substantially teach the invention as claimed. In addition, Appelman discloses the claimed “the instant message system provides online status (Appelman, col. 4, lines 24-30, col. 5, lines 52-55), which automatically determining an online status for each identified person by querying at least one messaging account server for each identified person.

As per claim 18 and 46-49, Lee, Thorner and Appelman substantially teach the invention as claimed. In addition, Appelman discloses the claimed “each presence indicator graphically represents the online status of each identified person” (Appelman, col. 5, lines 52-55).

As per claim 19, Lee, Thorner and Appelman substantially teach the invention as claimed. In addition, Appelman discloses the claimed “using instant messaging system to communicate with the person and display the online status of the person (Appelman, col. 4, lines 24-30, col. 5, lines 52-55), which includes the graphical representation of the online status of each identified person is automatically updated by re-querying the at least one messaging account server for each identified person.

As per claim 21, Lee and Thorner teach all the claimed subject matters as discussed in claim 20, except for explicitly disclosing the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person. Appelman teaches the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person (Appelman Fig. 28-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Lee and Thorner's combined system by incorporating the use of pop-up window as disclosed by Appelman (Appelman, Fig. 28-29). The motivation being to attract the user attention by using a pop-up window.

As per claim 22, Lee, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one context-sensitive menu for interacting with the retrieved information for each identified person (Appelman, Fig. 28-29).

As per claim 23, Lee, Thorner and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one hyperlink for accessing the retrieved information for each identified person via a computer pointing device (Appelman, Fig. 5).

***Remark***

11. Applicants asserted that Thorner does not disclose that the search criteria are not automatically derived. The examiner disagrees with the precedent assertion. However, when read and analyzed in light of the specification, the invention as claimed does not support Applicants' assertions. The claims do not capture the essence of the invention as argued in applicants' remark page 15. The aforementioned assertions, wherein the search criteria are not automatically derived fails to disclose by Thorner with regard to the invention of claim 1, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. It is important to note that applicants are interpreting the claims very narrow without considering the broad teachings of the reference used in the rejection. In the last office action, the examiner went through the claims phrase by phrase and referred to the prior art column and line number as to where he has drawn the correspondences between applicants' claimed invention phrases and prior art. By failing to address these correspondences, applicants have failed to rebut the examiner's prima facie case of obviousness uses for a different purpose, which does not alter the conclusion that its use in a prior art device would be prima facie obviousness from the purpose disclosed in the reference. Thorner, however, is directed to a system that provided desired information about a person's communication possibilities and residence in an easy way without any installation adapted to a particular kind of communication system. Thorner states that a complete information of persons and organizations communication addresses is given automatically if desired, so the search engine sends a menu to the computer client regarding probable subject information to be search, wherein the system automatically connects to a inquired person and then automatically request or search person of the desired interest. Such of system of Thorner

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provides that the search criteria is automatically derived. Therefore, applicants fail to provide prima facie evidence how the claimed invention differ from the cited prior art. Instead the applicant has provided numerous court decisions to backup such above assertion. Moreover, Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater 162 USPQ 541, 550-51 (CCPA 1969). Thorner substantially discloses the invention as claimed. Hence the 35 U.S.C 103 is hereby sustained.

12. Applicants asserted that neither lee, Thorner, Dimitrova, Sorensen, Yamakita nor Srinivasan teach the applicants claimed invention for automatically retrieving from at least one electronic database, information relating to each person resulting from the automatic parsing of an electronic document and there is no prima facie of obviousness has been established. The examiner disagrees with the precedent assertion. It is important, Applicants are interpreting the claims very narrow without considering the broad teachings of the reference used in the rejection. In the last office action, the examiner went through the claims phrase by phrase and referred to the prior art column and line number as to where he has drawn the correspondences between applicants' claims phrases and prior art. By failing to address these correspondences, Applicants have failed to rebut the examiner's prima facie case of obviousness uses for a different purpose which does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference.

(i). Lack of prima facie showing of obviousness under 35 USC103 (page 15).

Applicants cite *In Re Fine* in supporting their allegation with Lack of prima facie showing of obviousness under 35 USC103. In response to Applicants' arguments that neither Lee nor Thorner teach the applicants claimed invention for automatically retrieving from at least one electronic database, information relating to each person resulting from the automatic parsing of an electronic document, the examiner respectfully submits that Applicant misinterprets the references used in the rejection. The Court, *In re Fritch*, stated "the examiner can satisfy the above mentioned assertion only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references". *In re fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (Citing *In re Lalu*, 747, F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Each applied reference does not expressly suggest combination with the other respective references. The motivation referred to *In re Fritch* involves extensive changes to the primary references. Applicants are reminded that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. Furthermore, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya* USPQ 607 (CCPA 1975). On the other hand, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In



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re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. Thorner, however, is directed to a system that provided desired information about a person's communication possibilities and residence in an easy way without any installation adapted to a particular kind of communication system. Thorner states that a complete information of persons and organizations communication addresses is given automatically if desired, so the search engine sends a menu to the computer client regarding probable subject information to be search, wherein the system automatically connects to a inquired person and then automatically request or search person of the desired interest. Lee, on the other hand, provides a system of identifying personal names in an electronic file by automatically parsing the file into individual words and automatically identifying words or word sequences which represent candidate names and periodically download files over the network from an identified location, so for each download, identifying a personal name present in file and automatically generating a report containing the name. Therefore, one having ordinary skill in the art would have found it obvious to combine the teachings of the cited references, wherein the system for searching electronic files as disclosed by Lee would incorporate the use of automatically retrieving available information and providing at least one electronic interface for initiating communication with those identified person. One having ordinary skill in the art would have found it motivated to combine the teachings of the cited references in order to provide desired information about person's communication possibilities and residence in easy way without installation adapted to particular kind of communications system.

Therefor, the prima facie evidence has been established.

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(ii). Applicants appear to misinterpret the guidance given under MPEP 2142.

In particular, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

There are numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1596, 1598 (Fed. Cir. 1988) (Citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined *In re Lamberti et al.*, 192 USPQ 278 (CCPA) that:

- (a) obviousness does not require absolute predictability;
- (b) non-preferred embodiments of prior art must also be considered; and
- (c) the question is not express teaching of references, but what they would suggest.

(iii). According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement, that which is disclosed therein.

Furthermore, the skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the examiner for the reasons and motivations given above as well as in the prior office action. Thus the combined teachings of the Thorner and Lee when considered as a whole to one of ordinary skill in the art make obvious that Applicants dispute.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

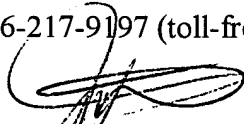
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M Corrielus  
Primary Examiner  
Art Unit 2162

January 23, 2006